

REMARKS

By the above amendment, claim 1 has been amended to recite additional features of the present invention, claims 5 and 7 have been canceled thereby overcoming the rejection under 35 USC 112, second paragraph, and obviating the objection to the drawings. Additionally, claims 6 and 8 have been amended and new claims 9 - 25 have been presented.

Turning first to the objection to the drawings, although applicants are unaware of the manner in which the features recited in claims 5 and 7 can be illustrated in a manner considered appropriate by the Examiner, in order to avoid such requirement for illustration, the features of claims 5 and 7 have been canceled at this time, thereby rendering the objection to the drawings and the rejection of claims 5 - 7 under 35 USC 112, second paragraph, moot.

By the present amendment, claim 1 has been amended to recite additional features as illustrated in Figure 26 of the drawings of this application, for example. More particularly, claim 1 recites the feature that the pixel electrode (PX) and the counter electrode (CT) are disposed on a same insulating layer (PSV) which is arranged under the first alignment film ORI1 and which is arranged over at least one of the image signal lines (DL) as illustrated in Fig. 26. Applicants note that newly presented claims 9 - 25 recite other features of the present invention. For example, new independent claim 9 corresponds to the features now recited in claim 1 other than the recitation of rubbing directions. New independent claim 15, referring to Fig. 26 shows a pair of counter electrodes CT arranged on opposite sides of an image signal line DL so that the image signal line is disposed between the counter electrodes of the pair, and a member (SH)

is provided on the first substrate (SUB1) so as to shield light in a region between the pair of counter electrodes, as described at page 88, line 27 to page 89, line 12, for example. It is noted that new independent claim 20 recite features similar to that of claim 15 in reciting the features that a member (SH) is provided on the first substrate and which is elongated in a same direction as a direction of the one of the image signal lines, and the member has an overlapping arrangement with the one of the image signal lines and the pair of counter electrodes, as is illustrated in Fig. 26, for example.

Independent claim 25 is also directed to the member or light shielding layer (SH) as illustrated in Fig. 26 and recites shielding means being provided for shielding light in a region between the counter electrode and the one of the image signal lines at the first substrate. Applicants note that the independent claims also recite other features of the liquid crystal display device. As to the newly added dependent claims, such claims more particularly define features as illustrated in Figures 25 and 29 of the drawings of this application, for example.

As to the rejection of claims 1 - 2 and 4 under 35 USC 103(a) as being unpatentable over Sumiyoshi et al, US Patent No. 5,726,721 in view of Togashi, US Patent No. 4,345,249, and the rejection of claims 1, 2 and 4 under 35 USC 103(a) as being unpatentable over Togoshi, US Patent No. 4,345,249, in view of Sumiyoshi et al, US Patent No. 5,726,721, such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

At the outset, as to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988),

wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

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In setting forth the rejection, the Examiner recognizes that Sumiyoshi et al do not disclose that the pixel electrode and the common electrode are formed on the same substrate. In fact, Sumiyoshi et al discloses that the pixel electrode and the common electrode are not formed on the same substrate, and that, the pixel electrode and the common electrode are formed on opposing substrates. That is, Sumiyoshi et al utilizes a vertical electric field whereas Togashi discloses an in-plane switching LCD. The Examiner contends that it would have been obvious to one skilled in the art to provide the claimed features. With regard to Togashi, the Examiner recognizes that this patent do not disclose that rubbing directions of the alignment layers on the first and second substrates are substantially parallel to each other, but contends that such features are disclosed in Sumiyoshi et al. Here again, the Examiner contends it would have been obvious to one skilled in the art at the time the invention was made to modify Togashi's device in the manner of Sumiyoshi et al so as to provide the claimed features. Applicants submit that the positions by the Examiner with respect to the modification of Sumiyoshi et al and/or Togashi represent a hindsight reconstruction attempt of the present invention in complete disregard of the teachings of the individual references. Thus, applicants submit that the claimed features of claim 1 as originally presented patentably distinguish over this cited art in the sense of 35 USC 103.

Furthermore, as noted above, claim 1 has been amended to define the feature, as illustrated in Figure 26, that the pixel electrode and the counter electrode are disposed on a same insulating layer which is arranged under the first alignment film and which is arranged over at least one of the image signal lines. It is apparent that such feature is not disclosed by Sumiyoshi et al in that as recognized by the Examiner,

Sumiyoshi et al do not disclose that the pixel electrode and the common electrode are formed on the same substrate and therefore, cannot be disposed on the same insulating layer. Likewise, such feature is not disclosed by Togashi. That is, while Togashi in Fig. 6 discloses display electrodes 23 and reference electrodes 13 formed on the same substrate, and irrespective of the Examiner's position that alignment layers are inherently formed on the first and second substrates, it is readily apparent that Togashi does not disclose an insulating layer on which the pixel electrode and the counter electrode are both provided and which insulating layer is arranged below an alignment layer and above an image signal line as disclosed and claimed herein. Thus, applicants submit that claim 1, as amended, and the dependent claims patentably distinguish over this proposed combination in the sense of 35 USC 103 and claims 1, 2, 4, 6 and 8 should be considered allowable thereover.

With respect to the newly added claims 9 - 25, applicants submit that neither Togashi nor Sumiyoshi et al disclose the features of the independent claims, as described above, in the sense of 35 USC 102 and/or 35 USC 103 whether such patents are considered alone or in any combination thereof. As such, applicants submit that these claims should also be considered allowable over the aforementioned cited art at this time.

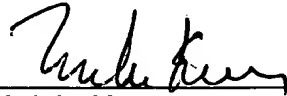
In view of the above-amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of

this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 501.37242CX2), and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in cursive script, appearing to read "Marvin Kraus", is written over a horizontal line.

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